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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/405,901	09/24/1999	CHARLES WECKEL	18561-051	1026

24319 7590 12/17/2004

LSI LOGIC CORPORATION  
1621 BARBER LANE  
MS: D-106  
MILPITAS, CA 95035

EXAMINER

AN, SHAWN S

ART UNIT	PAPER NUMBER
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2613

DATE MAILED: 12/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	09/405,901		WECKEL ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Shawn S An		2613	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 June 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 and 24-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-22 and 24-33 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### ***Response to Applicant's Election***

1. Applicant's election with traverse of Species I, Fig. 1, which corresponds to claims 1-22 and 24-33 in the reply filed on 6/14/2004, is considered improper.

Upon a further review, Species I, Fig. 1, an encoder according to an embodiment of the invention, reads on claims 1-22 and 24, whereas Species II, Fig. 2, a decoder according to an embodiment of the invention, reads on claims 25-33.

Applicant's response is improper because the Applicant has chosen to elect the entire set of claims, thereby failed to indicate to the Examiner which of the claims 1-22 and 24-33 read on the elected figure of the disclosed species.

Furthermore, the Applicant makes a second attempt to provisionally elect with traverse claims 25-33 (see Applicant's REMARKS), based on the Examiner's last office action (implied on page 3, second and third paragraphs).

However, the Applicant's election of the claims 25-33 is also improper, since Applicant has already chosen the Species I, which reads on claims 1-22 and 24 as discussed above. The claims 25-33 belong to the Species II, Fig. 2, the decoder.

In summary, the Applicant has chosen initially a species for an encoder, but electing the entire set of claims, whether traversed or not, and subsequently elects claims 25-33, but the claims 25-33 (decoder) read on the Species II.

Hence, the Applicant's response to the election/restriction is deemed improper based on the Applicant's improper election.

Therefore, the Examiner can't properly respond to the Applicant's traversal, unless the Applicant elects a single disclosed species on the basis of the corresponding figures as discussed above, and to indicate to the Examiner which of the claims 1-22 and 24-33 properly read on the elected figure of the disclosed species as discussed in the last election/restriction office action.

***Conclusion***

- 2 Any inquiry concerning this communication or earlier communications from the Examiner should be directed to **Shawn S An** whose telephone number is 703-305-0099. The Examiner can normally be reached on Flex hours (10).
3. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.
4. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



SSA

Primary Patent Examiner

12/10/04